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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/975,699	10/11/2001	Khaled Mahmud	97020CIP2CON2 (3600-091-0)	2387

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EXAMINER

THEXTON, MATTHEW

ART UNIT	PAPER NUMBER
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1714

8

DATE MAILED: 04/22/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Applicant(s)

09/975,699

Applicant(s)

MAHMUD ET AL.

Examiner

Matthew A. Thexton

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 25 March 2003.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 59-130 is/are pending in the application.
- 4a) Of the above claim(s) 82-94 and 118-130 is/are withdrawn from consideration.
- 5) ☒ Claim(s) 59-81 is/are allowed.
- 6) ☒ Claim(s) 95-117 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claim Rejections - 35 USC § 112

Claims 95-117 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Claim 95 is independent and claims 96-117 depend therefrom. Claim 95 concludes with the phrase "wherein said aggregate has silanol groups located at the surface of the aggregate." There does not appear to be any support for the noted phrase in the application. One does not know whether the silanol groups are organic or inorganic, or what conditions, steps, or techniques control their formation. One of ordinary skill in the art at the time of the invention would not know from the description that silanol groups are necessarily present, and would not know that the description requires that limitation.

Claims 95-117 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

Claim 95 is independent and claims 96-117 depend therefrom. Claim 95 concludes with the phrase "wherein said aggregate has silanol groups located at the

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surface of the aggregate.” There is no description in the application regarding the noted phrase. There is no explanation to guide the public in how to make the invention as claimed. There is no guidance on how to test for this feature. No working example refers to this feature. One does not know whether the silanol groups are organic or inorganic, or what conditions, steps, or techniques control their formation. Based on these deficiencies, there is a burden of undue experimentation to make, characterize or identify the material as claimed.

Priority

Applicant has not complied with one or more conditions for receiving the benefit of an earlier filing date under 35 U.S.C. 120 as follows:

The later-filed application must be an application for a patent for an invention which is also disclosed in the prior application (the parent or original nonprovisional application or provisional application); the disclosure of the invention in the parent application and in the later-filed application must be sufficient to comply with the requirements of the first paragraph of 35 U.S.C. 112. See *Transco Products, Inc. v. Performance Contracting, Inc.*, 38 F.3d 551, 32 USPQ2d 1077 (Fed. Cir. 1994).

This application repeats a substantial portion of prior Application No. 09/453419, filed 2 December 1999, and adds and claims additional disclosure not presented in the prior application. Since this application names an inventor or inventors named in the prior application, it may constitute a continuation-in-part of the prior application. Should

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applicant desire to obtain the benefit of the filing date of the prior application, attention is directed to 35 U.S.C. 120 and 37 CFR 1.78.

This application filed under former 37 CFR 1.60 lacks the necessary reference to the prior application. A statement reading "This is a Continuation-in-Part of Application No. 09/453419, now US patent 6364944, filed 2 December 1999...{and the other intervening applications}." should be entered following the title of the invention or as the first sentence of the specification. Also, the current status of all nonprovisional parent applications referenced should be included. Applicant's response of 25 March 2003 amended the statement of prior applications so as to cancel the amendment made in the preliminary amendment received 11 October 2001. The effect is to omit the three intervening applications and to refer only to 08/837493, filed 8 April 1997, now US patent 5904762. This is troublesome since 5904762 has no copendency with the present application.

Allowable Subject Matter

Claims 59-81 are allowed. These claims appear to be free of the prior art considered.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double

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patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 95-117 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-22 of U.S. Patent No. 6057387. Although the conflicting claims are not identical, they are not patentably distinct from each other because: based on the theory advanced by applicant that the difference between the sets of claims (i.e., the phrase "wherein said aggregate has silanol groups located at the surface of the aggregate") is inherent to the material of the issued patent, such material must be encompassed by the patented claims, either identically or in a way that requires no variation from the disclosure of the patent. An newly discovered inherent feature does not lend patentability to an otherwise old material.

Double Patenting

A rejection based on double patenting of the "same invention" type finds its support in the language of 35 U.S.C. 101 which states that "whoever invents or discovers any new and useful process ... may obtain a patent therefor ..." (Emphasis added). Thus, the term "same invention," in this context, means an invention drawn to identical subject matter. See *Miller v. Eagle Mfg. Co.*, 151 U.S. 186 (1894); *In re Ockert*, 245 F.2d 467, 114 USPQ 330 (CCPA 1957); and *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970).

A statutory type (35 U.S.C. 101) double patenting rejection can be overcome by canceling or amending the conflicting claims so they are no longer coextensive in scope. The filing of a terminal disclaimer cannot overcome a double patenting rejection based upon 35 U.S.C. 101.

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Claims 95-117 are rejected under 35 U.S.C. 101 as claiming the same invention as that of claims 1-22 of prior U.S. Patent No. 6057387. This is a double patenting rejection. Based on the theory advanced by applicant that the difference between the sets of claims (i.e., the phrase "wherein said aggregate has silanol groups located at the surface of the aggregate") is inherent to the material of the issued patent, such material would appear to be identical. Absent some evidence that the scope of these sets of claims are different, they appear to be the same scope.

Response to Arguments

35 USC 112, first paragraph, adequate description. Applicant states at page 7 "With respect to claims 95-117, a silanol group at the surface of the aggregate is an inherent property of an aggregate comprising a carbon phase and a silicon-containing species phase." Applicant then proceeds to describe a test and some test results purporting to show that silanol groups are present on aggregates. This is not found convincing because the information and arguments (1) do not constitute extrinsic evidence (2) must make clear that the feature is necessarily present and (3) that it would be so recognized by one of ordinary skill in the art at the time of the application for patent. 146 Hyatt v. Boone, 146 F.3d 1348, 1353, 47 USPQ2d 1128, 1131 (Fed. Cir. 1998), In re Robertson, 169 F.3d 743, 745, 49 USPQ2d 1949, 1950-51 (Fed. Cir. 1999). Such evidence must be submitted under 37 CFR 1.132.

Assertion of entitlement to benefit of earlier priority date. At pages 8-9, applicant asserts that the claim under 35 USC 120 as a "continuation" application is proper since the claims are inherently supported by the parent application. (It is assumed that

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applicant will restore the claim to priority identifying intervening applications that was canceled by the most recent amendment.) The examiner maintains the position that the present claims are not described as required by 35 USC 112 and therefore the type of application must be changed to "continuation-in-part" while acknowledging that if the claims are properly inherently supported then the claim for benefit of earlier priority date as "continuation" is proper.

The new abstract is noted and overcomes the objections of the earlier office action.

Amendments to the specification in response to examiner's objections are noted. The designation "N234 carbon black" was researched and found to a term of art and therefore acceptable. The objections to "incorporation by reference" are withdrawn in view of applicant's presentation at pages 10 and 11 that none of these references contain essential material. All other objections are overcome.

The Information Disclosure Statement was submitted timely, however there was no concise explanation of foreign language documents as required under 37 CFR 1.98 (a)(3)(i). As indicated in the prior office action, citations of non-English language documents have been lined through as they could not be considered, although in some cases, as indicated on the form 1449, English language equivalents were located and considered.

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Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Matthew A. Thexton whose telephone number is 703-305-5085. The examiner can normally be reached on Monday-Friday, 8:30 to 6.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vasudevan S Jagannathan can be reached on 703-306-2777. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9310 for regular communications and 703-872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0661.



Matthew A. Thexton
Primary Examiner
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April 18, 2003